REMARKS/ARGUMENTS

In the Office Action mailed May 21, 2009 (hereinafter, "Office Action"), claims 1, 11 and 20 stand rejected under 35 U.S.C. § 112. Claims 1, 3-7, 9-11, 13-16, 18-20, 22-26 and 28 stand rejected under 35 U.S.C. § 103. Claims 1, 11, 13, 20 and 22 have been amended. Claims 29-31 have been added.

Applicants respectfully respond to the Office Action.

I.   Claims 1, 11 and 20 Rejected Under 35 U.S.C § 112

Claims 1, 11 and 20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action indicated that the terms "any content of the imaging job" and "content of the imaging job" was unclear. Claims 1, 11 and 20 have been amended to address this rejection and clarify this issue. Accordingly, Applicants respectfully request that the rejection of claims 1, 11 and 20 be withdrawn.

II.   Claims 1, 3-7, 9-11, 13-16, 18-20, 22-26 and 28 Rejected Under 35 U.S.C. § 103(a)

Claims 1, 3-7, 9-11, 13-16, 18-20, 22-26 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0042884 to Wu et al. (hereinafter, "Wu") in view of U.S. Patent Application Publication No. 2003/0140009 to Namba et al. (hereinafter, "Namba") in further view of U.S. Patent Application Publication No. 2002/0046350 to Lordemann et al. (hereinafter "Lordemann"). This rejection is respectfully traversed.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims at issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. <u>KSR Int'l Co. v. Teleflex Inc.</u>, 550 U.S. 398, 2007 U.S. LEXIS 4745, at **4-5 (2007) (<u>citing</u> <u>Graham v. John Deere Co. of Kansas City</u>, 383 U.S. 1, 17-18 (1966)). As the Board of Patent Appeals and Interferences has recently confirmed, "obviousness requires a suggestion of all limitations in a claim." <u>In re Wada and Murphy</u>, Appeal 2007-3733 (<u>citing</u> <u>CFMT, Inc. v. Yieldup Intern. Corp.</u>, 349 F.3d 1333, 1342 (Fed. Cir. 2003)). Moreover,

the analysis in support of an obviousness rejection "should be made explicit." <u>KSR</u>, 2007 U.S. LEXIS 4745, at **37. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." <u>Id.</u> (citing <u>In re Kahn</u>, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Applicants respectfully submit that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the limitations in these claims.

Claim 1, as amended herein, provides:

> erasing <u>all</u> content of the imaging job both on a client device and an imaging device, the content of the imaging job comprising instructions configured to produce visible information on the imaging output<u>, wherein the imaging job was generated from the document by an application, and wherein the application is not part of the imaging job</u>.

(Added text underlined). Support for this amendment is found, for example, at paragraphs [41] [76], [86], and [95]-[98] and at Figure 8 of the pending application. This amendment clarifies that the imaging job was generated by an application and that the application is not erased. Rather, it is the content of the imaging job that is erased from both the client device and the imaging device.

The Office Action relies upon Wu to allegedly teach the action of "erasing residual data" as recited in claim 1. Specifically, the Office Action states as follows:

> 5.   Applicant argues that Wu (US Pub. No. 2002/0042884) fails to teach the amended claim limitation, "erasing residual data containing any content of the imaging job both on a client device and an imaging device, the content of the imaging job comprising instructions configured to produce visible information on the imaging output". Examiner respectfully disagrees.
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> 6.   Examiner would point out that, Wu teach this limitation as, (Page 8, paragraph 191, the sensitive part can be obtained from the hardware during printing and erased from memory immediately the printing process is completed) and (page 11, paragraph 277, the audit trail information is stored in the hardware and periodically uploaded to the server. The server maintains the audit trail for a predetermined period of time. After expiry of the predetermined period, it is deleted from the server). According to the specification of the invention, residual

data defined as, (page 7, paragraph 90, *residual data 624 is any data produced by computer processes* during the processing of an imaging job which includes from imaging job creation to final output. For example, residual data 624 includes intermediate data containing content of the imaging job from memory, such as disk and RAM. When a print job is created, the job generation process 604 may produce intermediate data, such as in a file or RAM, containing some or all of the content of the job, which is later processed into a final imaging job). Examiner interpreted residual data as any sensitive data that [is] erased or deleted by the printer (client side) or any audit trail information that is deleted by the server (sender side) of the system.

Office Action, pp. 2-3. This excerpt from the Office Action indicates that the term "residual data" is being interpreted as "any data produced by [the] computer processes," and as such, as long as Wu teaches that "sensitive data that [is] erased or deleted by the printer (client side)" and that "audit trail information that is deleted by the server (sender side) of the system," then Wu will satisfy the claim language. (Id.)

Applicant disagrees with the interpretation of the claim language set forth in the Office Action. However, as a result of the present paper, claim 1 has been amended to recite "erasing all content of the imaging job both on a client device and an imaging device, the content of the imaging job comprising instructions configured to produce visible information on the imaging output, wherein the imaging job was generated from the document by an application, and wherein the application is not part of the imaging job." As explained above, this claim language makes it clear that the "content of the imaging data" (not just any sensitive data) must be erased from both the client device and the imaging device. As recited by claim 1, "content of the imaging job" comprises "instructions configured to produce visible information on the imaging output" and differs from "non-content" of the imaging job (which does not produce visible information on the imaging output). (See Present specification at paragraph [86].) The application that generates the content is not erased.

It is clear that Wu does not teach or suggest this claim language. As noted above, the Office Action cites to page 8, paragraph [0191] of Wu to allegedly teach that the "residual data" is erased from the imaging device. (See Office Action at p. 4.) This paragraph of Wu states:

An attacker has virtually unlimited time to attack the client software, but attacking hardware is far more difficult. Therefore, the sensitive part [of the client software] can be obtained from the hardware during printing, and erased from memory immediately the printing process is completed. A very skilled attacker

may be able to successfully attack the client software and print unlimited copies of document, but the copies will be noticeably invalid because there is no optical watermark for authentication.

Wu, paragraph [0191]. While this paragraph of Wu discloses that a "sensitive part can be . . . erased," this phrase refers to "client software" that performs functions (such as "watermark generating functions" and "access control") rather than content of an imaging job, as required by claim 1. (Wu at paragraphs [0184]-[0191].) This point is supported by the fact that Wu states that the "sensitive part [of the client software] can also be installed in the client's machine together with the basic part of the client software." (Wu at paragraph [0189] (emphasis added).) The "client software" of Wu thus clearly refers to installable software rather than document "content" comprising "instructions configured to produce visible information on the imaging output". Thus, there is no teaching in Wu of "erasing all content of the imaging job both on a client device and an imaging device, the content of the imaging job comprising instructions configured to produce visible information on the imaging output, wherein the imaging job was generated from the document by an application, and wherein the application is not part of the imaging job," as required by claim 1. Likewise, the Office Action has not cited a portion of Lordeman or Namba that would allegedly teach this claim element.

In view of the foregoing, Applicants respectfully submit that claim 1 is patentably distinct from the cited references. Accordingly, Applicants respectfully request that the rejection of claim 1 be withdrawn because Wu, alone or in combination with Namba and Lordemann, does not teach or suggest all of the subject matter of claim 1.

Claims 3-7 and 9-10 depend either directly or indirectly from claim 1. Accordingly, Applicants respectfully request that the rejection of claims 3-7 and 9-10 be withdrawn.

Claim 11 has been amended to recite instructions that are executable to "erase all content of the imaging job on the client device, the content of the imaging job comprising instructions configured to produce visible information on imaging output, wherein the imaging job was generated from the document by an application, and wherein the application is not part of the imaging job." This claim further recites instructions executable to "erase all content of the imaging job on the recipient imaging device." As discussed above, Wu, alone or in combination with Namba and Lordemann, does not teach or suggest this claimed subject matter. Accordingly, Applicants respectfully submit that claim 11 is allowable. Claims 13-16 and 18-19

depend either directly or indirectly from claim 11, and are therefore allowable for at least the same reasons.

Claim 20 has been amended to recite instructions that are executable to "erase all content of the imaging job both on a client device and an imaging device, the content of the imaging job comprising instructions configured to produce visible information on the imaging output, wherein the imaging job was generated from the document by an application, and wherein the application is not part of the imaging job." As discussed above, Wu, alone or in combination with Namba and Lordemann, does not teach or suggest this claimed subject matter. Accordingly, Applicants respectfully submit that claim 20 is allowable. Claims 22-26 and 28 depend either directly or indirectly from claim 20, and are therefore allowable for at least the same reasons.

III.   **New Claims**

New claims 29-31 have been added. New claim 29 depends from claim 1. New claim 30 depends from claim 11. New claim 31 depends from claim 20. Accordingly, these claims are allowable for the same reasons put forth above in conjunction with the independent claims.

New claims 29-31 each recite that "the content of the imaging job is immediately erased from both the client device and the imaging device." Support for this language is found in the specification at paragraph [98]. Thus, these claims require that the content of the imaging job must be immediately erased from both the client device and the imaging device. Again, the Office Action relies on Wu regarding the "erasing" of the data. However, the cited portion of Wu teaches as follows:

> the audit trail information is stored in the hardware and periodically uploaded to
> the server. The server maintains the audit trail for a predetermined period of time.
> After expiry of the predetermined period, it is deleted from the server.

Wu, paragraph [0277]. Such a teaching clearly does not satisfy the "immediately" erasing requirement of claims 29-31. Allowance of these claims is requested.

IV.   <u>Conclusion</u>

      Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

                               Respectfully submitted,

                               /Wesley L. Austin/

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                               Wesley L. Austin
                               Reg. No. 42,273
                               Attorney for Applicant

Date: August 21, 2009

AUSTIN RAPP & HARDMAN
170 South Main Street, Suite 735
Salt Lake City, Utah 84101
Telephone: (801) 537-1700